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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,791	10/18/2005	Gabrielle Sore	278073US0PCT	6093

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EXAMINER	
MATTISON, LORI K	

ART UNIT	PAPER NUMBER
1619	

NOTIFICATION DATE	DELIVERY MODE
06/26/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/553,791	Applicant(s) SORE ET AL.	
	Examiner LORI MATTISON	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-31 is/are pending in the application.
- 4a) Of the above claim(s) 22, 23, 25, and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-21, 24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/18/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. All correspondence regarding this application should be directed to Group Art Unit 1619.

Status of the Claims

Applicant's amendments filed on 10/18/2005 have been entered. Claims 1-12 have been cancelled. Claims 13-31 have been added. Claims 13-31 remain pending in the current application, of which claims 13-21, 24 and 26-30 are being considered on their merits. Claims 22, 23, 25, and 30 remain withdrawn from consideration at this time.

Election/Restrictions

Applicant's election with traverse of Group I, claims 13-21, and 24-31 in the reply filed on 04/07/2009 is acknowledged. The traversal is on the ground(s) that the examiner has not provided adequate reasons or examples to support the conclusion of patentable distinctness between the identified groups (Reply, page 3, paragraph 2). Applicant points to sections of the M.P.E.P., M.P.E.P. § 802.02 and 806.03 (page 4, paragraphs 1 and 5), which pertain to United States utility applications rather than international applications to support their traverse.

The examiner has considered applicant's traverse and is not persuaded. The examiner cites Hua and Banks which teach the process and the concentration of humectant (urea). The step in common with each of the groups is step 13, which was known at the time of the invention. However, the process and composition of step 13 was known at the time the invention was made. Therefore, it can not be considered the special technical feature which links the Groups.

With regard to the recitations of M.P.E.P. § 802.02 and 806.03 in the allegation that the examiner has improperly applied a restriction requirement in the examination of an international application, the examiner asserts that M.P.E.P. § 802.02 and 806.03 are applied to national applications filed under 35 U.S.C. 111 and not international applications filed under PCT receiving national phase examination (35 U.S.C. 371). The section of the M.P.E.P. that pertains to international applications filed under the Patent Cooperation Treaty and their national phase examination (35 U.S.C. 371) is chapter 1800 of the M.P.E.P. M.P.E.P. § 1850 clearly states that PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims without regard to the practice in national applications filed under 35 U.S.C. 111 in restriction practice. Therefore, the consideration of claims under of M.P.E.P. § 802.02 and 806.03 is not correct practice for this application. Restriction based upon lack of unity under PCT Rules 13.1 and 13.2 is the correct practice. Examination on the merits will commence on Group I claims 13-21, 24, 26-30 which comprise of applicant's elected group and species.

Specification

The abstract of the disclosure is objected to because the applicant has provided a WIPO coversheet, with extraneous material, rather than just the abstract. Correction is required. See MPEP § 608.01(b).

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

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As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The specification of the disclosure is objected to because the headings are not provided in the specification, making it difficult to determine which parts are present and their order.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 13-16, 20, 21, 26, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,720,949 (Davis, 1998), US Patent No. 5,656,280 (Herb, 1997), UK Patent Application GB 2092444 (Brun, 1982), US Patent No. 5,690,945 (Bui-Bertrand, 1997) and US Patent No. 4,548,728 (Franklin, 1985).

With respect to claim 13, Example 1 of Davis teaches a process and a cream composition (i.e. first composition; column 12, lines 30-end; column 13, lines 1-25). Example 1 teaches the process of applying a first composition, which comprises water as the physiologically acceptable medium, to the face (column 12, lines 65-end). The cream composition is left on the face for about 10 minutes (column 13, lines 10-20). The skin is then washed (column 13, lines 10-20). Davis teaches that the cream may comprise 0-25% of a nonliquid organic material (column 3, lines 30-45). The nonliquid organic material may be an emollient, humectant, or other skin conditioning function that is incorporated in lieu of an oil emollient because oil emollients tend to suppress the foaming action of the effervescent agent (column 4, lines 35-50). The regimen is taught to improve skin tone, texture, and softness and removes dead cells that cling to the surface of the skin and accentuate the discontinuities in the surface of the skin. Additionally the regimen is taught to alleviate localized skin inflammation caused by bacteria (column 12, lines 5-20). With respect to claim 14, the composition is left on the face for about 10 minutes (column 13, lines 10-20). With respect to claim 16, although

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not expressly stated, the cream taught by composition must comprise a continuous phase of water as the composition comprises 73.89% water and emulsifying agents such as cetyl alcohol. Thus it is inherent that the essential oil, present in an amount of 0.01%, is dispersed in the continuous phase of water (column 12, lines 35-65). With respect to instant claims 20 and 21, the cream composition comprises the thickener, xanthan gum (column 12, lines 35-65). With regard to instant claim 26, Example 1 teaches application to the face such as the forehead, cheeks, and chin (column 12, lines 50-end; column 13, lines 1-20). With respect to claim 27, Davis teaches that the acid, such as the lactic acid used in the process of Example 1, may be used in excess of 20% when a gentle peel of the skin is desired (column 11, lines 35-50).

Davis does not teach a cream which includes at least 20% urea as set forth by instant claim 13.

Davis does not teach removal of the composition rinsing as set forth claim 13.

Davis does not teach a cream composition which comprises 20-50% urea, as set forth by instant claim 15.

Davis does not immediately envisage a process that is a peeling process as set forth by instant claim 27.

Davis does not teach removal of the composition rinsing with water as set forth claim 30.

Herb teaches that urea is a skin conditioner (column 10, lines 40-60) that is for dry skin (column 25, lines 5-15). Herb exemplifies use of urea in a topical preparation in an amount of 7.6% (Table IV, Example 92 Col. 39-40).

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Brun teaches that urea is a commonly humectant which may be used in an amount from 30-42 % in topically applied cosmetic compositions (page 1, lines 10-15; page 1, line 30-40).

Bui-Bertrand teaches that cosmetic masks (title) may be removed by washing with water and rinsing (column 2, lines 10-15).

Franklin teaches that most cosmetic mask facials require that the composition be rinsed off with warm water (column 1, lines 30-40).

With respect to instant to instant claim 13, have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified the process taught by Example 1 of Davis through modification of the process steps by inclusion of a rinsing step and modification of the composition used in the process of Example 1 of Davis by adding at least 20% urea to the composition because Davis teaches that nonliquid organic material may be included in the composition in an amount from 0-25% and that these nonliquid organic materials may be an emollients, humectants, or other skin conditioners and urea is a nonliquid organic humectant/skin conditioner which may be used in concentrations from 7-42% in topical cosmetic preparations as taught by Herb and Brun and cosmetic masks are taught to be removed in processes that include washing and/or rinsing steps as taught by Bui-Bertrand and Franklin.

With respect to instant to instant claim 15, have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified the process taught by Example 1 of Davis through modification of the composition used

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in the process of Example 1 of Davis by adding 0-25% urea to the composition because Davis teaches that nonliquid organic material may be included in the composition in an amount from 0-25% and that these nonliquid organic materials may be an emollients, humectants, or other skin conditioners and urea is a nonliquid organic humectant/skin conditioner which may be used in concentrations from 7-42% in topical cosmetic preparations as taught by Herb and Brun.

With respect to instant claim 27, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have looked to the teachings of Davis and modified the composition used in the process of Example 1 by using 20% or more acid to result in a peeling process because Davis suggests such a modification to produce such a peeling process, with the skilled artisan desiring a fresh skin appearance resulting from removal of dead cells as occurs in the peeling process.

With respect to instant claim 30, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified the process of Example 1 of Davis by adding a step that comprises rinsing with water because Bui-Betrand and Franklin teach that mask compositions may be removed in a process which includes the step of washing and/or rinsing and Franklin specifically teaches that the rinsing step occurs with water.

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Claim 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, Herb, Brun, Bui-Bertrand and Franklin as applied to claims 13-16, 20, 21, 26, 27, and 30 above, and further in view of US Patent No. 5,972,359 (Sine, 1999).

Davis teaches that the regimen is taught to improve skin tone, texture, and softness and removes dead cells that cling to the surface of the skin and accentuate the discontinuities in the surface of the skin. Additionally the regimen is taught to alleviate localized skin inflammation caused by bacteria (column 12, lines 5-20).

Davis does not teach that process is performed to attenuate one or more of a wrinkle, a fine line, pigmentation mark and an acne scar on the skin as set forth by instant claim 24.

Davis does not teach that the process is one wherein the skin is in need of treatment for at least fine lines and wrinkles as set forth by instant claim 29.

Sine teaches that skin discontinuities comprise wrinkles, including both fine superficial wrinkles and coarse deep wrinkles, skin lines, crevices, bumps and large pores (column 3, lines 33-end).

With respect to claim 24, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified the process taught by Example 1 of Davis by using it in a process to attenuate one or more of a wrinkle or a fine line because Davis teaches that his regimen removes dead cells that cling to the surface of the skin and accentuate the discontinuities in the surface of the skin and Sine teaches that skin discontinuities are fine and deep wrinkles, skin lines, and crevices.

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With respect to claim 29, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to modified the method taught by Example 1 of Davis by applying the composition used in the process of Example 1 to skin in need of treatment for at least one wrinkles, fine lines, pigmentation marks and acnes scars because Davis teaches Davis teaches that his regimen removes dead cells that cling to the surface of the skin and accentuate the discontinuities in the surface of the skin and Sine teaches that skin discontinuities are fine and deep wrinkles, skin lines, and crevices.

Claims 17, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, Herb, Brun, Bui-Bertrand, Franklin and Sine as applied to claims 13-16, 20, 21, 24, 26, 27, 29, and 30 above, and further in view of US Patent No. 4,014,995 (Juliano, 1977) and US Patent No. 4,333,927 (Ofuchi, 1982) .

With respect to claim 17, Davis teaches that his first composition may comprise an organic solvent (column 2, lines 15-30) which may include isopropyl alcohol (a three carbon alcohol, isopropanol) and propylene glycol (a three carbon glycol). With respect to instant claim 19, Davis teaches that his first composition may comprise an organic solvent (column 2, lines 15-30) which may include isopropyl alcohol (a three carbon alcohol, isopropanol) and propylene glycol (a three carbon glycol) (column 9, lines 10-30). Davis teaches that the organic solvent is typically a mono or dihydric alcohol but does not require it to be mono or dihydric alcohol (column 9, lines 10-35). Davis also teaches use of an essential oil to provide a cooling effect (column 8, lines 1-15). Davis

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also teaches that his regimen alleviates localized skin inflammation caused by bacteria (column 12, lines 5-20).

Davis does not teach the elected species of compound, ethanol, as set forth by instant claim 17.

Davis does not teach the elected species of compound, ethanol, as set forth by instant claim 18.

Davis does not teach the elected species of compound, ethanol, as set forth by instant claim 19.

Example 9 of Juliano teaches a skin treatment mask which reduces the appearance of wrinkles. The mask comprises ethyl alcohol (i.e. ethanol) as the organic solvent and water was the inorganic solvent (column 12, lines 20-65)

Ofuchi teaches that it is advantageous to add ethanol to skin preparations since it has bacteriostatic action and provides a cooling effect upon application to the skin (column 3, lines 20-40).

With respect to claim 17, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified the process taught by Example 1 of Davis through modification of the mask composition used in Example 1 through inclusion of ethanol in the mask composition because Davis teaches that his composition may comprise organic solvents and other reagents which provide a cooling effect and alleviate inflammation caused by bacteria and ethanol is an organic solvent which has been used in mask compositions as taught by Juliano which provide

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a cooling effect and bacteriostatic action when applied to the skin in topical preparations as taught by Ofuchi.

With respect to claim 18, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified the process taught by Example 1 of Davis through modification of the mask composition used in Example 1 through inclusion of ethanol in the mask composition because Davis teaches that his composition may comprise organic solvents and other reagents which provide a cooling effect and alleviate inflammation caused by bacteria and ethanol is an organic solvent which has been used in mask compositions as taught by Juliano which provide a cooling effect and bacteriostatic action when applied to the skin in topical preparations as taught by Ofuchi.

With respect to claim 19, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified the process taught by Example 1 of Davis through modification of the mask composition used in Example 1 through inclusion of ethanol in the mask composition because Davis teaches that his composition may comprise organic solvents and other reagents which provide a cooling effect and alleviate inflammation caused by bacteria and ethanol is an organic solvent which has been used in mask compositions as taught by Juliano which provide a cooling effect and bacteriostatic action when applied to the skin in topical preparations as taught by Ofuchi.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, Herb, Brun, Bui-Bertrand, and Franklin as applied to claims 13-16, 20, 21, 26, 27, and 30 above, and further in view of US Patent No. 6,231,840 (Buck, 2001).

Davis teaches that the process may be used to improve skin tone, texture, and softness and removes dead cells that cling to the surface of the skin and accentuate the discontinuities in the surface of the skin (column 12, lines 5-20). Davis goes on to teach that the acid used in the composition, such as the lactic acid, may be used in excess of 20% when a gentle peel of the skin is desired (column 11, lines 35-50).

Davis does not teach that the process for improving skin tone and texture through removal of dead skin cells that cling to the skin surface to accentuate discontinuities of the skin includes removal of one or more layers of the epidermis or dermis of the skin as recited by instant claim 28.

Buck teaches that methods to reverse the appearance of fine lines and surface blemishes (i.e. discontinuities in skin) involves use of various "peeling" agents which remove the outer epidermis including the keratinous stratum corneum (i.e. epidermal layers) and attack the lower dermal layer to stimulate new collagen production. Increased collagen production has the effect of reducing age lines in the epidermis (column 7, lines 35-50).

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified the process taught by Davis through inclusion of high concentrations of lactic acid (i.e. peeling agent) in the composition to remove one or more layers of the dermis and epidermis because Davis teaches that the

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concentration of acid, such as lactic acid, may be increased when the gentle peeling is desired and Buck teaches that use of peeling agents remove the outer epidermal layer and stimulate the dermal layers to produce collagen which has the effect of reducing the appearance of skin discontinuities, such as fine wrinkles, which is the goal of Davis's regimen.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. M./

Examiner, Art Unit 1619

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615